

REMARKS

In the August 17, 2004 Office Action, the Examiner noted that claims 1-19 were pending in the application; rejected claims 17-19 under 35 U.S.C. § 101; and rejected claims 1-19 under 35 U.S.C. § 103(a). In rejecting the claims, U.S. Patents 6,332,126 to Peirce et al. (Reference A in the May 30, 2003 Office Action) and 6,466,918 to Spiegel et al. (Reference A in the August 17, 2004 Office Action) were cited. Claims 1-19 remain in the case. The Examiner's rejections are traversed below.

Examiner's Comments Regarding Spelling and Confusion

In the Examiner's Note in the third paragraph on page 2 of the Office Action, the Examiner questioned spelling in claim 8 and the words "comprising: wherein" in claim 14. Since there was nothing misspelled in the phrase identified by the Examiner, it is assumed that the Examiner did not follow how "said receiving" was being modified and therefore, claim 8 has been amended to clarify this limitation. In addition "comprising:" has been removed from claim 14.

Rejections under 35 U.S.C. § 101

On pages 2-4 of the Office Action, claims 17-19 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The preambles of claims 17-19 have been amended to conform to the terminology used on page 53, lines 7-16 of the application which describes how a program is supplied to the computer. It is submitted that this language falls within an acceptable variation of the language used in MPEP § 2106 which sets forth the Examination Guidelines for Computer Related Inventions. Therefore, withdrawal of the rejection under 35 USC § 101 is respectfully requested.

If the Examiner does not agree that the amended language in claims 17-19 meets the requirements of 35 USC § 101, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview prior to issuing another Office Action, for the purpose of discussing what amendments would be acceptable.

Rejections under 35 U.S.C. § 103

On pages 5-19 of the Office Action, claims 1-19 were rejected under 35 U.S.C. § 103(a) as unpatentable over Peirce et al. in view of Spiegel et al. As noted above, Peirce et al. was first cited in the May 30, 2003 Office Action and the teachings of Peirce et al. were discussed in the Amendments received by the U.S. Patent and Trademark Office on September 3, 2003 and March 22, 2004.

Spiegel et al. is directed to a system for “exposing” popular nodes within a browse tree, by scoring the popularity of information of one category based on activity data of a community, to a user who is a member of the community and uses information in the category. Membership in the community may be defined by users who explicitly join the community, or whose membership “is based on information known about the user, such as the user’s e-mail domain, Internet service provider, purchase history, or shipping address” (column 2, lines 65-67).

Nothing has been cited or found in Peirce et al. or Spiegel et al. regarding “qualification criterion information for qualifying membership of a corresponding service and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service” (claim 4, lines 4-6). The cited portion of Spiegel et al. simply lists types of information that may be included in defining a group of users to whom information should be presented. As discussed in the previous two Amendments, Peirce et al. only discloses that “merchants must satisfy the Merchant Qualification Criterion” (column 5, lines 47-48), while cardholders are targeted based on characteristics defined by merchants or “dealmakers” (e.g., column 5, lines 59-65) and whether cardholders receive offers generated by merchants or dealmakers is controlled by issuers of credit cards “by providing merchant exclusion and prioritized parameters for each Card Group” (column 9, lines 17-19). Thus, no suggestion has been found in Peirce et al. or Spiegel et al. of determining qualification for a “second service by referring to the membership qualification table of the second service and checking that the identification information of the first service is included in the qualification criterion information of the second service when the user is utilizing the first service” (claim 4, last three lines).

The language used in the first paragraph on page 6 of the Office Action may or may not be an accurate description of what is taught by Peirce et al., but it is not a description of what is recited in claim 4. The differences between the claims and the teachings of Peirce et al. were described in Amendment received by the U.S. Patent and Trademark Office on March 22, 2004 and entered by the Request for Continued Examination filed May 18, 2004. By failing to even reference the language recited in the claims, the August 17, 2004 Office Action fails to rebut the arguments made in the March 22, 2004 Amendment. It is submitted that replacing Yoshioka et al. with Spiegel et al. does not overcome the deficiencies of Peirce et al. described in the March 22, 2004 Amendment.

In the last paragraph on page 6 of the Office Action, the Examiner asserted that “*by referring to the membership qualification table of the second service ... of the second service is non-functional language and given no patentable weight*” citing *In re Danly* 263 F.2d 844, 847,

120 USPQ 528-531 (CCPA 1959). In addition, *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App. & Inter. 1987) was cited in support of this position (the page numbers of both USPQ citations have been corrected). However, both of these decisions involved apparatus claims, while claim 4 is directed to a "processing system". Thus, it is submitted that *In re Danly* and *Ex parte Masham* are not applicable. This is supported by the holding of *In re Lowry*, 32 F3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) in which a claim directed to "a memory for storing data for access by an application program being executed on a data processing system" was found valid over the prior art, despite the fact that the body of the claim recited the contents of the memory, not its structure. If the cases cited by the Examiner were applicable to data processing systems, the holding of *In re Lowry* would have been that it was obvious, since there were no limitations directed to the structure of the memory. For the above reasons, it is submitted that claim 4 and claims 1-3 and 5 which depend therefrom patentably distinguish over Peirce et al. in view of Spiegel et al.

The Examiner also cited *In re Danly* and *Ex parte Masham* in refusing to give patentable weight to limitations recited in claims 2, 6, 7 and 15. Since claims 2, 6, 7 and 15 are all directed to a processing system, it is submitted that this is an incorrect application of the holding in these cases and that all of the language in all of the claims should be given patentable weight for the reasons discussed above with respect to claim 4.

In addition, the language used in describing what is taught by Peirce et al. and Spiegel et al. does not make a *prima facie* case of obviousness with respect to claims 6, 9, 10, 12, 13, 15, 16, 18 and 19 when all of the limitations are properly given patentable weight. Specifically, nothing has been cited or found in either Peirce et al. or Spiegel et al. regarding the "simulating device" (claim 6, line 6) or "simulating means" (claim 16, line 6); the limitations recited in claims 9, 12, 15 and 18 that are similar to those quoted above from claim 4; the operation of "comparing each membership condition of the service tables of the existing services in a membership qualification system with the new membership condition" (claim 10, lines 7-8); or the limitations in claims 12 and 19 similar to those quoted from claim 10. These limitations were apparently ignored without even citing any authority for doing so. Furthermore, claims 9 and 18 are directed to a "computer-readable recording medium" or a "computer accessible transfer medium" and therefore, are even closer to the memory that was the subject matter of the claims of *In re Lowry*. Since the remaining claims depend from the claims discussed above, it is submitted that all of claims 1-19 patentably distinguish over Peirce et al. in view of Spiegel et al.

Non-finality of Next Office Action

Since the August 17, 2004 Office Action failed to address all of the limitations in all of the claims, it is submitted that if the claims are not allowed, the next Office Action should not be a final Office Action, because if it addresses all of the limitations in the claims it would be the first time that all of the limitations were addressed since the Request for Continued Examination was filed on May 18, 2004.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination do not teach or suggest the features of the present claimed invention, all of which recite patentable subject matter. Thus, it is submitted that claims 1-19 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 12/17/04

By: Richard A. Gollhofer
Richard A. Gollhofer
Registration No. 31,106

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501